

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY R. OAR and GREGORY J. MAY

Appeal 2007-3423
Application 10/081,005
Technology Center 2100

Decided: December 11, 2007

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 23-31. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. INVENTION

The disclosed invention is generally directed to conserving power in computing systems. More particularly, Appellants' invention provides for a system in which a portable computer in sleep mode is awakened by an event (i.e., a wireless communication from a personal digital assistant), then responds to the event (Spec. 4).

B. ILLUSTRATIVE CLAIM

Claim 23, which further illustrates the invention, follows:

23. A method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant, the method comprising the following:

- waking the portable computer from the sleep mode in response to the wireless communication from the personal digital assistant;

- recognizing the wireless communication by the portable computer;

- responding to the wireless communication by the portable computer, including the following:

 - generating a response, and

 - transmitting the response to the personal digital assistant, the transmitting being performed via another wireless communication transmission; and,

- returning the portable computer to the sleep mode.

C. REJECTION

Claims 23-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,785,724 (“Drainville”) and U.S. Patent No. 6,317,831 (“King”).

II. CLAIM GROUPING

1 “When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(vii) (2005).¹

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

Here, Appellants argue claims 23-31 as a group. (App. Br. 8-19).² We select claim 23 as the sole claim on which to decide the appeal of the group.

III. ISSUES

“Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007). The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently” *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)).

At the outset, we note that Appellants have presented no arguments directed to the combinability of Drainville and King. Accordingly, Appellants have waived any such arguments, and the combinability of the references will not be addressed here. See 37 C.F.R. § 41.37(c)(1)(vii) (2005) (“Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.”).

² Appellants place claims 26 through 31 in different headings in the Appeal Brief, and repeat language from claim 23, but rely on the same argument with respect to alleged deficiencies in Drainville and King, as applied against claim 23. (App. Br. 13-19).

Appellants dispute the Examiner's finding that claim 23 is unpatentable over Drainville and King and assert that "Drainville does not disclose or discuss any portable computers" (App. Br. 8). The Examiner finds that "server 22 (of Drainville) is capable of being moved and is thus portable." (Ans. 8). The Examiner further states that "it would have been obvious to one of ordinary skill in the art at the time of invention that a server would need to be portable . . ." and also cites extrinsic evidence supporting the contention that portable computer servers were known in the art (*Id.*). Appellants argue that because remote device 22 of Drainville is "wired to an idle phone line 38 through modem 16" (App. Br. 9), the remote device 22 is not a portable computer. We apply a standard definition to construe the term "portable computer" as a computer that is movable. We do not agree that a computer is not movable merely because the computer is wired to a phone line through a modem. Laptop computers are typically considered to be portable even when wired to a phone line through a modem. Also, Appellants have not provided any evidence that one of ordinary skill in the art would understand that a computer wired to a phone line is not portable. For these reasons, we agree with the Examiner that server 22 of Drainville encompasses a portable computer.

Appellants further argue that "Drainville does not disclose or discuss a personal digital assistant" (App. Br. 8); "King does not disclose or suggest communication between a personal digital assistant and a personal computer in a sleep mode" (*id.* 9); "King does not disclose any entity being in sleep

mode or being awakened from a sleep mode” (*id.* 10); “Drainville does not disclose ... a portable computer being awakened from a sleep mode by a personal digital assistant” (*id.*); “Drainville does not disclose or suggest ... a wireless response” (*id.*); and “King does not disclose any communication that wakes up a portable computer ... entity and does not disclose or suggest any transmissions being made in response to a portable computer ... being awakened from a sleep mode” (*id.* 11).

We are unpersuaded by Appellants’ arguments because each of the arguments is directed to individual references in isolation rather than the combination of references as a whole. The Court of Appeals for the Federal Circuit has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Here, we agree with Appellants that Drainville does not disclose a personal digital assistant, a portable computer being awakened from sleep mode by a personal digital assistant, or a wireless response. However, Drainville must be read, not in isolation, but for what it fairly teaches in combination with prior art as a whole. We find King explicitly teaches a personal digital assistant (col. 15, l. 53) and a wireless response (Fig. 9). Likewise, although we agree with Appellants that King does not disclose a communication that wakes up a portable computer or a transmission made in response to a portable computer being awakened from sleep mode, we find that Drainville discloses these features (col. 1, ll. 62-64, App. Br. 10).

Appellants also argue that “[i]n Drainville, client 10 does not communicate with the on-demand web server 22 until after web server 22 has been awakened . . . [t]herefore, no communications . . . from client 10 is used to wake up the on-demand server” (App. Br. 12). The Examiner finds that claim 23 requires no more than a computer being awakened from sleep mode “in response to” a communication and that the web server 22 awakens from sleep mode “in response to” a communication from the client 10 (Ans. 10). We agree with the Examiner. Claim 23 does not require that a communication for awakening a computer be sent directly from a client to the computer with no intervening or intermediary devices. In Drainville, client 10 “initiates a request” (col. 5, l. 7) and, in response to the request, a server 30 “manages connection request to remote devices 22 such as the on-demand web server” (col. 5, ll. 1-4). The “on-demand server is accessible after a wake-up connection from the server in response to a request from a client computer” (col. 1, ll. 62-64). Drainville thus discloses waking the server from sleep mode “in response to” a communication from the client computer.

Because Appellants have failed to demonstrate the Examiner erred in rejecting claim 23, we affirm the rejection of claim 23, and of claims 24-31, which fall therewith.

IV. ORDER

In summary, the rejection of claims 23-31 under § 103(a) is affirmed.

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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